

### **Remarks**

Claims 15-19, 23-25, and 27-88 are pending in this application.

Claims 28 and 29 have been allowed. Claims 18, 25, 27, 38-40, and 42 have been objected to as being dependent on rejected base claims but were declared to be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

Claims 25, 27 and 42 have been rewritten in independent form to incorporate all limitations of claim 15 as previously presented. Thus, applicants believe that these claims are in condition for allowance. Applicants also note that claim 35 is dependent on allowed claim 28 and thus should be in condition for allowance as well.

Claims 15, 19, 43 and 84 have been amended. Support for the amendment to claim 15 can be found on page 4, line 34 of the disclosure. Claim 17 has been canceled.

New claims 89-98 are presented herewith. Claim 89 corresponds to previously pending claim 15 but is limited in that the R<sup>7</sup> residue is more narrowly defined when R<sup>3</sup> is formula IIIa. New claim 89 is introduced for canceled claim 17. Claims 90-98 are drawn to specific compounds, pharmaceutical compositions comprising those compounds and methods of using them. These compounds are ST293 (page 17, second compound) , ST312 (page 18, fourth compound) and ST315 (page 18, sixth compound) as disclosed in Table 1 of the present application.

### **Indefiniteness rejections**

In paragraphs 1 and 2 of the Action, the Office rejects claims 19, 41, 43-88 as indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

In particular, the Office states that claim 19 defines "X1 and X2" to be OH, NH<sub>2</sub> etc and thus does not comply with the tetra valency of carbon, rendering the claims indefinite. The Office further states that claim 43 defines in the proviso, that CH<sub>2</sub>X<sup>1</sup> can not be CH<sub>3</sub>COOH<sub>2</sub> and thus allegedly renders the claim indefinite.

In response, Applicants have amended claims 19 and 84 to change CH<sub>2</sub>-X<sup>1</sup>-X<sup>1</sup>-CH<sub>2</sub> to CH-X<sup>1</sup>-X<sup>1</sup>-CH. Applicants have also amended claim 43 to amend CH<sub>3</sub>COOH<sub>2</sub> to CH<sub>2</sub>COOH.

These amendment were made solely to correct typographical errors and shall not be construed as a surrender of subject matter.

Applicants note . that these indefiniteness rejections were the only rejections made in the context of claims 19, 41 and 43-88. Applicants believe that the amendments made herein put these claims in condition for allowance.

### ***Obviousness Rejections***

In paragraphs 4 and 5, the Office rejects claims 15-16, 23-24 and 30-37 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,534,546 to Honda et al.

The Office alleges that Honda et al. teach structurally similar compounds and compositions. In particular, the Office refers to claim 1 in column 262, when R<sub>1</sub> is NH<sub>2</sub>, m and n are 0, R<sub>2</sub> to R<sub>4</sub> are H. The Office also refers to the structure in column 31, lines 55-60 (example 36).

Applicants respectfully submit that the Honda reference was cited for the first time in the final Office Action of July 31, 2003. Applicants also note that in response to the Office Action of March 25, 2003, Applicants had made some changes that were

solely designed to bring the pending use claims into a format acceptable under U.S. standards. Applicants respectfully submit that the claim amendments made could have been reasonably expected. The claims were amended to pharmaceutical composition, compound and method of treatment claims. The claims rejected under 35 U.S.C. §103(a) are pharmaceutical composition claims comprising compounds substantially identical to those presented in the previously submitted use claims. Applicants also note that the Office appears to have treated the "use claims" that were pending at the time the Office Action of March 25, 2003 issued as compound claims as reflected in the rejection under 35 U.S.C. §102(b) made in this Office Action. In the present Office Action, the Office alleges that "Honda et al. teach structurally similar **compounds** and compositions as claimed herein." Accordingly, Applicants respectfully submit that the rejection over Honda could have been made in the Office Action of March 25, 2003. Thus, in order to allow for the development of clear issues between Applicants and the Examiner (MPEP §706.07), Applicants respectfully request that the finality of the rejection of claims 15-16, 23-24 and 30-37 be withdrawn.

Applicants' undersigned representative called Examiner Kumar to discuss the potential removal of the finality of the Office Action on October 30, 2003. Applicants forwarded the arguments stated above. Examiner Kumar indicated that he would consider a well founded argument for removing the finality of an Office Action, but encouraged Applicants to file a written statement and/or petition. Thus, since no agreement could be reached during the telephone discussion, applicants submit the above written statement supporting removal of the finality of the rejection. Favorable consideration is respectfully requested.

Nonetheless, Applicants have amended claim 15 to bring it in better condition for allowance. Applicants also note that among the wide array of examples provided by Honda only two contain the guanidine group of the presently claimed invention.

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RESPECTFULLY SUBMITTED,			
NAME AND REG. NUMBER	Joyce von Natzmer, Reg. No. 48,120		
SIGNATURE		DATE	10/31/03
Address	Rothwell, Figg, Ernst & Manbeck 1425 K Street, N.W., Suite 800		
City	Washington	State	D.C.
Country	U.S.A.	Teleph one	202-783-6040